

REMARKS

Claims 1-44 are pending in the present application. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of November 2, 2004, the following actions were taken:

(1) Claims 1, 2, 9-13, 16-22, 24-26, 28-31, and 34 were rejected under 35 U.S.C 102(b) as being anticipated by U.S. Patent No. 4,804,411 (hereinafter "Eida"); and

(2) Claims 3-8, 14, 15, 23, 27, 32, and 33 were objected to as being dependent upon a rejected base claim, but were indicated as allowable if rewritten in independent form.

It is respectfully submitted that the presently pending claims be reconsidered and allowed. Applicants submit that each and every amendment throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Rejection under 35 U.S.C. § 102

Before discussing the rejections, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. ' 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Specifically, Claims 1, 2, 9-13, 16-22, 24-26, 28-31, and 34 were rejected under 35 U.S.C. 102(b) as being anticipated by Eida. Eida discloses various dimeric and trimeric dye structures bonded together with a linking group, where each of the dyes bonded together are identical. However, Eida does not teach of forming dyes that would be stable in the presence of interfering metals. Eida only teaches the presence of metals in two contexts: 1) metals can be present as part of a metalized dye, which by definition are a required component of the dye *per se*, and thus, cannot be interfering; and 2) alkali metal salts can be present, such as lithium chloride and sodium chloride, when the ink is used in an ink-jet system of the type which charges the ink, i.e. salt present as a resistance controller.

The Applicants also claim metalized dyes as possible dyes for use, but as explained, these metals are not considered to be “interfering metals” as defined by the Applicant. To the contrary, they are necessary metals in these particular embodiments. With respect to Eida teaching the presence of the use of lithium chloride and sodium chloride, and more specifically, with respect to claims 1 and 25, these claims have been amended to clarify that the interfering metals can only be aluminum, one or more transition metal, or combinations thereof. Transition metals and aluminum are significantly different types of metals than alkali metals found in column 1 of the periodic chart. Support for these amendments to claims 1 and 25 can be found in the specification on page 6, lines 3 to 10 where the term “interfering metals” is described. Specifically, this definition states that “[t]he term ‘interfering metals’ includes aluminum as well as transition . . .” Though the term “interfering metals” can be broader than merely transition metals and aluminum (as evidenced by the term “includes”), claims 1 and 25 have been amended to cover only aluminum and transition metals as its interfering ions. This narrowing was not carried through to allowed claims 35-44, as there is at least one other element that distinguishes these claims over the prior art. For example, claims 35-44 require the presence of a specific media type, which is neither taught nor suggested by the prior art. Reconsideration of these rejections is respectfully requested.

Regarding some of the dependent claims, there are a few of these claims that appear to have been erroneously listed as being rejected, or alternatively, rejections should be removed. For example, claims 10 and 29 are drawn to two different colored dyes attached together by a linking group. Thus, if claim 3 is considered to

be allowable, which requires two different dye structures, then claim 10 should also be allowable (as different colored dyes would require different structures). Further, claims 12 and 30 require that the linker group is a triazine. None of the linker groups in Eida are triazines. Triazines are only disclosed as part of the dye structure *per se*, typically at a terminal end of the dye that is distal to the linking group. Claims 18-22 describe cycloalkylene linker groups. The prefix "cyclo" indicates a ring structure, the term portion "alkyl" is synonymous with saturated, and the suffix "ene" refers to the fact that it is attached to other organic groups. Thus, aromatic or aryl rings would not be considered to be cycloalkylene. As Eida does not show any saturated hydrocarbon rings as linker groups, this rejection is also thought to be not supported by the prior art. Thus, reconsideration of at least these dependent claim rejections is also respectfully requested.

In view of the foregoing, Applicants believe that claims 1-44 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any
overpayment to Deposit Account No.08-2025

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Respectfully submitted,



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